

**REMARKS/ARGUMENTS**

In respond to the objection of Claims 7, 36, 42, 52, 54, 55, 63-65 and 71, Claims 7, 36, 42, 52, 54, 55, 63-65 and 71 have been amended. The title and specification of the invention also have been amended.

Reconsideration of the application is respectfully requested for the following reasons:

Rejection of Claims 1, 5, 6, 9-14, 20, 23, 24-29, 33, 34, 40, 43, 44-49, 52, 65, 53, 55-60 and 69 Under Nonstatutory Double Patenting

This rejection is respectfully traversed on the grounds that claims 1, 20, and 52 has been amended to exclude a portable receiving terminal, as recited in the claims of copending U.S. Patent Application Ser. No. 09/712,957.

Objection Under 35 USC §112, 1st Paragraph

This objection has been addressed by amending the specification to correct various grammatical and idiomatic errors, including those noted by the Examiner in item 5 on page 2 of the Official Action.

Rejection of Claims 1-5, 20, 39, 40, 42 Under 35 U.S.C. §112, 2nd Paragraph

This rejection has been addressed by revising the claims to be in proper U.S. format and to correct various grammatical and idiomatic errors.

Rejection of Claims 1, 2, 5-12, 15, 16, 18, 19, 20-27, 30, 31, 33-38, 40-47, 50-58, 61-68 and 70 Under 35 U.S.C. §102(e)

Claims 1, 2, 5-12, 15, 16, 18, 19, 20-27, 30, 31, 33-38, 40-47, 50-58, 61-68 and 70 are rejected under 35 U.S.C. §102(e) as being anticipated by Duphorne et al.(U.S. 6,212,265). In the rejected claims, Claims 1, 20, 40 and 52 are independent.

This rejection is respectfully traversed on the grounds that the Duphorne patent fails to disclose or suggest a method of notifying users of new mail in which the electronic mail provider creates identification information, transforms the information into a transmission signal, and transfers the signal to a receiving terminal, as claimed.

Instead, the Duphorne patent teaches applications of existing wire-line public switched telephone networks and Caller Identification ("CallerID") systems operated by local telephone companies utilized to deliver email notification to users via the users' telephone lines. The system of Duphorne queries the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon and, if so, causes an associated Caller ID server of, for instance, the local telephone company to send an email notification signal in a format compatible with existing Caller ID protocols to an email notification device using a public switched telephone network. Thus, while Duphorne teaches notification of new mail, the notification is not in the form of a transmission signal transformed by the electronic mail provider to include identification information created by the provider.

In some embodiments disclosed in the Duphorne patent, email notification signals are transmitted during telephone ringing intervals and, in other embodiments, are transmitted prior to the first telephone ringing signal. In one embodiment, an email notification signal

containing at least a portion of the text of unread email received by and/or stored on the user's ISP email server is transmitted to the user via the public switched telephone network. None of these signals corresponds to the claimed transformed identification information.

It is quite clear that the system of Duphorne must query the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon. Because the ISP email server of Duphorne are passive, the method and system of Duphorne are different from that of the claimed invention. The ISP email server 16a must receive a query signal from a query software maintained by a central office 14 first or an information service provider so as to transmit a preliminary email notification signal in response to the query signal while the identification information and the transmission signal of new email of the claimed invention are created, transformed and then is transmitted to a receiving terminal by a email provider or a ISP email server. Moreover, the steps of transmitting a query signal to the remote email server and transmitting, in response to the query signal, a preliminary email notification signal from the remote email server to a central office coupled to a public switched telephone network of Duphorne cannot be omitted since this modification would result in an incomplete subject matter which Duphorne particularly pointed out and directed to. Duphorne actually discloses a different method and system from the claimed invention, which notifies users of the arrival of their email without the need of maintaining an online connection. Therefore, the teaching of Duphorne is insufficient to render the claimed invention anticipating by one person with ordinary skill in the art and withdrawal of the rejection is respectfully requested.

With respect to claim 20, the method and system of Duphorne passively transmit email notification signals after receiving the query signal during telephone ringing intervals and, in other embodiments,

transmit the email notification signals prior to the first telephone ringing signal while the claimed invention allows the users to receive transmission signals actively transferred from an email provider.

With respect to claim 40, the Duphorne patent does not mention a modulating means for transforming an identification information to a transmission signal. The system of Duphorne queries the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon and, if so, causes an associated Caller ID server of, for instance, the local telephone company to send an email notification signal in a format compatible with existing Caller ID protocols to an email notification device using a public switched telephone network. The system of Duphorne sends an email notification signal in a format compatible with existing Caller ID protocols to an email notification device and there is no need of a modulating means for transforming an identification information to a transmission signal.

With respect to claim 52, the Duphorne patent teaches an email notification device for receiving a Caller ID-compatible email notification signal indicating the existence of unread email messages addressed to a user and stored on an email server associated with the user. The email notification device for receiving a Caller ID-compatible email notification signal comprises an input terminal coupled to receive the email notification signal transmitted from a Caller ID server over a local loop of an associated public switched telephone network, a microprocessor for processing the email notification signal, a memory for storing information associated with the email notification signal, an alert indicating means for alerting the user of receipt of the email notification signal, and the email notification signal representing alphanumeric data related to at least a portion of a text message of one or more email received on the remote email server. The input terminal

of Duphorne is coupled to receive the email notification signal transmitted from a Caller ID server while the receiving means of the claimed invention receives a transmission signal which is transferred from an electronic mail provider.

Rejection of Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60 and 71-83 Under 35 U.S.C. §103(a)

Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60 and 71-83 are rejected under 35 U.S.C. §103(a) as being unpatentable over Duphorne in view of Ozaki (U.S. 5,933,478).

Like the Duphorne patent, the Ozaki fails to disclose or suggest an ISP email server that creates identification information and transforms it into a notification signal, as claimed. Even though Ozaki discloses an active ISP email server which can actively transmit a preliminary email notification signal and suspend a connection between the email provider and the receiving terminal, the combination of Ozaki would not have suggested modification of the method or system of Duphorne since the system of Duphorne must query the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon.

With respect to claim 71, the method of Duphorne provides a user with a Caller ID-compatible email notification signal indicating that email addressed to the user is received at a remote email server associated with the user. The method comprises the step of transmitting a query signal to the remote email server, a step of transmitting, in response to the query signal, a preliminary email notification signal from the remote email server to a central office coupled to a public switched telephone network, a step of formatting the preliminary email notification signal into the Caller ID-compatible email

notification signal according to one or more parameter values, and a step of transmitting the Caller ID-compatible email notification signal from the central office to the user using the public switched telephone network. As a result, the method and system as well as the subject matter of Duphorne are different from that of the claimed invention. The ISP email server 16a must receive a query signal from a query software maintained by a central office 14 first or an information service provider so as to transmit a preliminary email notification signal in response to the query signal. Therefore, a step of suspending a connection between the electronic mail provider and the receiving terminal when no the response message is received within the predetermined period would not be necessary for the teaching of Duphorne since a step of transmitting a query signal to the remote email server and a step of transmitting, in response to the query signal, a preliminary email notification signal from the remote email server to a central office coupled to a public switched telephone network are previously performed. Even if Ozaki disclosed the step of suspending a connection between a email provider and the receiving terminal when no said response message is received within said predetermined period, the combination of Duphorne and Ozaki would have required the user's ISP email server to be queried to determine whether any email addressed to the user is received by and/or stored thereon at first.

With respect to claims 17, 32, 39 and 69, although Clayton (U.S. 5,875,234) discloses that the UART format is typically used for Caller ID services and Huna teaches a switch device for controlling operation the receiving terminal respectively, the respective teachings of Clayton and Huna do not disclose the elements of the claimed invention which the teaching of Duphorne does not mention. It is respectfully submitted that the combinations of Duphorne and Clayton as well as Duphorne and Huna are not sufficient to render the claimed invention prima facie obvious.

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

BACON & THOMAS, PLLC

A handwritten signature in black ink, appearing to be 'B. Urcia', with a long horizontal stroke extending to the right.

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